

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#19

In re Reissue Application of

Tomowaki TAKAHASHI

Serial No.: 09/659,375

Group Art Unit: 2872

Confirmation No.: 5004

Filed: September 8, 2000

Examiner: J. Henry

For: CATADIOPTIC PROJECTION SYSTEMS

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PETITION UNDER 37 CFR 1.181

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Petition is to the requirements made by the Examiner forming the basis of the final rejection of claims under 35 U.S.C. §251 as discussed in the Final Office Action mailed March 12, 2002. The Final Office Action has a discretionary 37 C.F.R. §1.181(f) period set to expire on May 13, 2002 (May 12, 2002 being a Sunday). Pursuant to the Petition, the Applicant respectfully requests the invocation of Supervisory Authority pursuant to 37 C.F.R. §1.181(a)(3) as outlined below.

Appellant submits this Petition along with the Petition fee of \$130.00 set forth in 37 C.F.R. §1.181(d).

STATEMENT OF FACTS

On September 8, 2000, the Applicant filed a reissue application submitting newly presented broadening claims pursuant to 35 U.S.C. §251. The reissue application was filed, and the broadening claims presented, within two-years of the issuance of U.S. Patent No. 5,805,334. U.S. Patent No. 5,805,334 issued on September 8, 1998. A signed Reissue Declaration was filed on November 21, 2000 in response to a Notice of Missing Parts and perfected the filing date of September 8, 1998.

In the Office Action mailed February 13, 2001, the Examiner rejected claims 1-57 as being based upon a defective Reissue Declaration in violation of 35 U.S.C. §251. Specifically, in item 2 on page 2, the Examiner admitted that the “none of the claims newly presented in reissue are purely narrower than any of the patent claims.” (emphasis in original). However, on pages 2-3, the Examiner asserted that the error relied upon as the basis for reissue is improper in view of 35 U.S.C. §251 as interpreted by In re Weiler, et al., 229 USPQ 673 (Fed. Cir. 1986) (hereinafter referred to as “In re Weiler, et al.”) The Examiner asserted that In re Weiler, et al. establishes a requirement in 35 U.S.C. §251 that there be unity of invention between the invention recited in the newly presented claims as compared to the invention recited in the patent claims. Such unity of invention is evidenced by an allowable linking claim linking the subject matter of the recited invention.

As applied to the instant application, the Examiner asserted that the subject matter of the patent claims and the subject matter of the newly presented claims do not appear to relate to an unclaimed allowable linking claim directed to the newly claimed subject matter minus the term “dioptric.” As such, the Examiner asserted that the newly presented claims are “entirely distinct” from anything claimed or intended to be claimed. On this basis, the Examiner asserts that the Reissue Declaration is defective and non-compliant with 35 U.S.C. §251 as interpreted by In re Weiler, et al.

No analysis was made or otherwise pro-offered as a basis for this interpretation based upon existing patent office regulations. There was further no analysis of a provision in patent office regulations or in the Manual of Patent Examining Procedure (hereinafter referred to as the “MPEP”) requiring the unity of invention requirement as outlined by the Examiner. Further, no discussion was included as to an interpretation of In re Weiler, et al. contained in the MPEP which is consistent with the Examiner’s requirement. Lastly, no analysis was made of subsequent case law interpreting Manual of Patent Examining Procedure which contained the requirement of the unity of invention as defined by the Examiner or that explicitly overrode the

procedures required in the MPEP for use in the interpretation of 35 U.S.C. §251.

In an Amendment filed April 13, 2001, the Applicant agreed that the newly presented claims are broader. However, on pages 8-9, the Applicant noted to the Examiner that "unity of invention" is not the standard outlined in MPEP 1412.01. MPEP 1412.01 provides the official procedures by which compliance with 35 U.S.C. §251 is measured with regard to a requirement that the newly presented claims be directed to the same general invention. The Applicant noted that the "unity of invention" requirement appears to be related to the restriction requirements discussed in MPEP 800. Instead, the Applicant submitted that the proper standard required by MPEP 1412.01 is "(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C §112 first paragraph is satisfied; and (B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application." The Applicant further noted that the requirement asserted to be required is not required in subsequent case law, such as in In re Amos, 21 USPQ2d 1271 (Fed. Cir. 1991) as interpreted in MPEP 1412.01. Based upon this standard, the Applicant submitted that, since claims 1-57 are compliant with 35 U.S.C §112 first paragraph and there is no indication of an intent not to claim the subject matter of the newly presented claims, the newly presented claims 27-57 are compliant with 35 U.S.C. §251.

On May 29, 2001, the Examiner mailed a Final Office Action finally rejecting claims 1-57 as not being compliant with 35 U.S.C. §251. In the Final Office Action, the Examiner again asserted on page 3 that the proper standard for reviewing compliance with 35 U.S.C. §251 is based upon In re Weiler, et al., and that the newly presented claims are directed to "entirely distinct inventions."

With regard to the procedures in MPEP 1412.01, the Examiner asserted on page 4 that the procedures in MPEP 1412.01 "cannot supercede Weiler" since it is the courts who are the final arbiters for constructions of a statute. However, the Examiner did not provide or discuss

any subsequent case law in which the interpretation made by the Examiner of 35 U.S.C. §251 using In re Weiler, et al. was both found to be proper and also found to be in direct conflict with the procedures of the MPEP.

On September 18, 2001, the Applicant filed a Request for Continued Examination submitting, among other items, an Amendment and a Supplemental Reissue Declaration. In the Amendment, new claim 58 was added as another broadening reissue claim. The new claim 58 was supported by the Supplemental Reissue Declaration, which relied upon new claim 58 as providing an additional error on which reissue can be based.

On October 31, 2001, the Examiner mailed an Office Action rejecting claims 1-58. The Examiner renewed the rejection of claims 1-57 again based upon 35 U.S.C. §251 using the Examiner's interpretation of In re Weiler, et al. On page 3 of the Office Action, the Examiner rejected claim 58 as not being allowable, and thus not curing the Examiner's requirement for an allowable linking claim since doing so would allow the Applicant to circumvent the holding in In re Weiler, et al. and to render the holding of In re Weiler, et al. without force.

The Examiner rejected claim 58 under 35 U.S.C. §102(b) in view of Friedman (U.S. Patent No. 4,779,966).

On January 30, 2002, the Applicant filed an Amendment in which claim 58 was distinguished from Friedman. On pages 7-9, the Applicant interpreted the holding of In re Weiler, et al. in light of subsequent case law, and noted that the MPEP does not even discuss In re Weiler, et al. in the context of requiring a unity of invention. Further, the Applicant noted that, to the extent that In re Weiler, et al. and subsequent case law are in agreement, the current interpretation of In re Weiler, et al. does not impose a requirement that the invention not be to "entirely distinct" inventions.

On page 8, the Applicant noted to the Examiner that the procedures of the MPEP are more than mere administrative procedures, but instead are the current procedures "that the

examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application." (Forward of MPEP).

The Applicant submitted a Second Supplemental Reissue Declaration with the Amendment. The Second Supplemental Reissue Declaration claimed the priority benefit or various U.S. and foreign patent applications. The Second Supplemental Reissue Declaration further relied upon the new claim of priority as providing an additional error upon which reissue can be based.

On March 12, 2002, the Examiner mailed a Final Office Action. On page 3 of the Office Action, the Examiner allows claims 1-26 and 58. On pages 3 through 16, the Examiner again rejects claims 27-57 as being directed to subject matter entirely distinct from that of the patent claims such that the newly presented claims are directed to a separate invention as asserted to be required by In re Weiler, et al.

Further, the Examiner again asserts on page 12 that the Examiner has authority to make interpretations of 35 U.S.C. §251 contrary to the express procedures required by the MPEP since the Examiner's authority stems from Federal Court precedent as interpreted by the Examiner, and not from mere administrative constructions of the statute as contained in the MPEP. As such, on page 11, the Examiner asserts that the Applicant's reliance upon the MPEP is merely an avenue to avoid the requirements of In re Weiler, et al.

ISSUES TO BE REVIEWED

1. Whether an Examiner is required to examine all claims in a reissue application once a broadening claim has been entered and relied upon as an error as required in the Manual of Patent Examining Procedure, or whether the Examiner may selectively consider ones of broadening claims.
2. Whether an Examiner is required to comply with the rules of analysis specified in the Manual of Patent Examining Procedure as to whether a reissue application is for the "same invention" when subsequent court and agency interpretations have

not found a direct conflict between the procedures and 35 U.S.C. §251, or whether an Examiner is entitled to rely upon his own interpretation of case law in apparent conflict with the procedures specified in the Manual of Patent Examining Procedure.

ARGUMENT

- A. The Examiner is required to consider all claims in a reissue application where one proper error for broadening reissue is presented.

In general, a Petition under 37 C.F.R. §1.181 is appropriate in any action or requirement from an Examiner not otherwise subject to appeal to the Board of Patent Appeals and Interferences. 37 C.F.R. §1.181(a). Where an Examiner's action is contrary to the rules and procedures of the U.S. Patent and Trademark Office, the invocation of Supervisory Authority to correct the erroneous action is proper.

In the Final Office Action of March 12, 2002, the Examiner allows newly presented claim 58. Since newly presented claim 58 is a broadening claim and is relied upon as an error upon which reissue may be based in the Second Supplemental Declaration, the Applicant has presented at least one error upon which reissue can be based. Since the Applicant is only required to present one error, there is no basis by which the Examiner can refuse to consider the remaining newly presented claims since there is no requirement for *all* errors to be considered a proper basis for reissue. See, 37 CFR 1.175(a)(1), MPEP 1414. As such, once one error is found to be a proper basis for a reissue application, any remaining changes can be made without their having to be detailed in the declaration.

While the Applicant does not agree with the Examiner's interpretation of In re Weiler, et al. and does not agree that the newly presented claims are directed to entirely distinct inventions as compared to the patent claims, even assuming *arguendo* that the Examiner is correct, it is noted that the Applicant has complied with the requirements of 35 U.S.C. §251 and 37 CFR 1.175(a)(1). Thus, it is respectfully requested that the Supervisory Authority be invoked to

require the Examiner to withdraw the rejection of claims 27-57 under 35 U.S.C. §251 since the Applicant has complied with the requirements of 37 CFR 1.175(a)(1) in supplying at least one error upon which reissue can be based.

B. The Examiner is required to follow the statutory interpretation of 35 U.S.C. §251 required by MPEP 1412.

1. Procedures in the MPEP are required to be followed unless found by a court of competent jurisdiction to be contrary to the express language of a statute.

The MPEP represents a set of authorized procedures “that the examiners *are required or authorized* to follow in appropriate cases in the normal examination of a patent application.”

(Forward of MPEP). While it has been argued that the MPEP represents mere administrative guidelines, it has also been noted that the MPEP is more than just internal guidance. For instance, in In re Fressola, 22 USPQ2d 1828, 1832 (Comm’s Patents. 1992), the Commissioner found that the “PTO can prescribe requirements in the MPEP, providing these requirements are not inconsistent with statute, rules, or case law.” In this way, the requirements of the MPEP do not represent *ultra vires* actions by the Commissioner, but instead provide rules and regulations which examiners are required to follow. Id. It is through the MPEP that the U.S. Patent and Trademark Office is able to promote uniformity in the examination of patent applications.

In addition, the public is entitled to rely on the provisions of the MPEP in the prosecution of an application before the U.S. Patent and Trademark Office. Ex parte Yamaguchi, 61 USPQ2d 1043, 1046 (Bd.Pat. App& Interf. 2001)(unpublished) citing In re Kaghan, 156 USPQ 130, 132 (CCPA 1967). Thus, where the MPEP outlines a procedure that is not clearly contrary to statute or case law, the public is entitled to rely upon and the examining corps is required to follow the examination procedure. In re Kaghan, 156 USPQ at 132. It is only where a court has found the MPEP to be in direct conflict with the express language of applicable law that the MPEP is not to be followed. E.g., Ethicon Inc. v. Quigg, 7 USPQ2d 1152 (Fed Cir. 1988) (provision of MPEP in direct conflict with law and is invalid and not enforceable). As such, while

the courts retain an inherent power to interpret the statutes independent from the power of the U.S. Patent and Trademark Office to provide procedures by which examination of patents are conducted, such a decision as to whether the MPEP is to be followed is not left to the individual Examiner. Allowing such individual discretion as to whether an MPEP procedure is to be followed would appear contrary to the purpose of the MPEP in providing a uniform set of procedures which the Examiners are required to follow and on which the public can rely during the examination process.

2. MPEP 1412 has not been shown to violate a statute such that the Examiner is required to follow, and the Applicant is entitled to rely upon its procedures.

In the instant application, the Examiner has rejected claims based upon an interpretation of 35 U.S.C. §251 using In re Weiler, et al. As noted above, the Applicant does not agree with the Examiner's interpretation of In re Weiler, et al. and note that the Examiner's interpretation appears to be in conflict with the procedures required in MPEP 1412. Specifically, MPEP 1412.01 requires that "claims presented in a reissue application *are considered to satisfy the requirement* of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where: (A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and (B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application" (emphasis added). Thus, according to the MPEP, there is no requirement for a linking claim as asserted by the Examiner.

Further, while the Examiner believes that the procedures of MPEP 1412.01 are overruled by In re Weiler, et al., it is noted that the Examiner has not pointed to a court case or opinion from the Commissioner which supports a theory that MPEP 1412 is no longer an enforceable policy. Instead, it appears that the Examiner has determined, without support, that the MPEP 1412 is unenforceable.

In addition, the Applicant does not agree that the newly presented claims are directed to entirely distinct subject matter. However, even assuming arguendo that the newly presented claims are directed to entirely distinct subject matter, other portions of the MPEP as well as 35 U.S.C. §251 appear to support the use or reissues to obtain coverage for newly presented claims drawn to entirely different subject matter. For instance, 35 U.S.C. §251 directs that the "Director may issue several reissued patents for distinct and separate parts of the thing patented." Based upon this provision, 37 C.F.R. §1.177 discusses procedures for use in reissue in divisionals. Various provisions of the MPEP also discuss using restriction practice and divisionals in the examination of a reissue application. E.g., MPEP 1450 (discussing procedures for analyzing whether reissue applications a restriction requirement is appropriate if the newly presented claims are drawn to "separate and distinct inventions"), MPEP 1451 (discussing filing multiple divisional applications in reissue). As such, MPEP 1412 appears to reflect a statutory and regulatory presumption that reissue applications can and should be used to obtain claim coverage for separate and distinct inventions.

Since the Examiner has not found a case in which the requirements of MPEP 1412 have been found unenforceable, since the Applicant is entitled to rely on the procedures outlined in the MPEP in the prosecution of the Application, and since the Examiner's requirement appears inconsistent with 35 U.S.C. §251, 37 C.F.R. 1.177, and MPEP 1450, 1451 containing provisions specifically allowing newly presented claims drawn to separate and distinct inventions, it is respectfully requested that the Supervisory Authority be invoked so as to require the Examiner to follow the procedures in MPEP 1412 in determining whether the newly presented claims are compliant with 35 U.S.C. §251. Further, it is respectfully requested that the Supervisory Authority require the Examiner to withdraw the final rejection under 35 U.S.C. §251 as not being consistent with the procedures of the U.S. Patent and Trademark Office as compiled in the MPEP.

RELIEF REQUESTED

Based upon the above, it is respectfully requested that the Supervisory Authority specified in 37 C.F.R. §1.181(a)(3) so as to require the Examiner to withdraw the rejection of claims 27-57 under 35 U.S.C. §251 since the rejection does not conform with approved U.S. Patent and Trademark Office rules and regulations.

If there are any additional fees associated with the filing of this Petition, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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